

Appln. No. 10/789,596

Amendment dated November 4, 2004

Reply to Office Action mailed September 22, 2004

REMARKS

Reconsideration is respectfully requested.

Claims 1 and 3 through 8 remain in this application. Claim 2 has been cancelled. Claim 9 has been added.

The Examiner's rejections will be considered in the order of their occurrence in the Office Action.

Paragraphs 4 and 5 of the Office Action

Claims 1, 5 and 6 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,340,067 to Martin et al.

It is submitted that the Martin reference does not disclose, teach or suggest "said base member comprising a receiving aperture, said receiving aperture extending through said base member, said receiving aperture being adapted for receiving the computer mouse such that said base member extends around periphery of a lower portion of the computer mouse, said base member being adapted for frictionally engaging the computer mouse, said receiving aperture being adapted for permitting the computer mouse to function when said base is coupled to the computer mouse". The Official Action states that the Martin reference discloses "the receiving aperture being adapted for receiving the computer mouse such that the base member extends around periphery of a lower portion of the computer mouse". The Martin reference teaches an apparatus that cradles the mouse by only extending around three sides of the mouse and extends up the height of the mouse and therefore does not meet the requirements of the applicant's claims. Further, for claims to be anticipated by a reference that reference must describe every element of those claims as well as those elements must be arranged as is required by the claims as expressed in MPEP 2131 stated below.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a

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single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

"The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. In *re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). Note that, in some circumstances, it is permissible to use multiple references in a 35 U.S.C. 102 rejection. See MPEP § 2131.01."

Therefore, it is submitted that the Martin reference would not lead one to anticipate the combination of features as claimed by the applicant.

Withdrawal of the §102(b) rejection of claims 1, 5 and 6 is therefore respectfully requested.

Paragraphs 6 and 7 of the Office Action

Claims 3, 4, 7 and 8 have been rejected under 35 U.S.C. Section 103(a) as being unpatentable over Martin in view of Rice.

The law regarding obviousness is clear--any modification of the prior art must be suggested or motivated by the prior art:

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

Appln. No. 10/789,596

Amendment dated November 4, 2004

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It is submitted that the combination of Martin with Rice is not suggested by the prior art, and even if such a combination were to be made, one would not be led to the combination of features recited in applicants' claims. In particular, the references do not disclose, teach or suggest "said base member comprising a receiving aperture, said receiving aperture extending through said base member, said receiving aperture being adapted for receiving the computer mouse such that said base member extends around periphery of a lower portion of the computer mouse, said base member being adapted for frictionally engaging the computer mouse, said receiving aperture being adapted for permitting the computer mouse to function when said base is coupled to the computer mouse". As discussed above, the Martin reference fails to teach the base member extending around the periphery of the lower portion of the computer mouse to allow the mouse to function while maintaining positioning of the base member with respect to the computer mouse as claimed by the applicant. The Rice reference teaches an ergonomic data entry device that fails to teach the base member extending around and frictionally engaging the periphery of the lower portion of the computer mouse to allow the mouse to function while maintaining positioning of the base member with respect to the computer mouse as claimed by the applicant. Therefore, it is submitted that the combination of the Martin reference with the Rice reference would not lead one to the combination of features as claimed by the applicant.

It is also submitted that the mere fact that one may argue that the prior art is capable of being modified to achieve a claimed structure does not by itself make the claimed structure obvious--there must be a motivation provided by the prior art, and that motivation is totally lacking in the reference.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness.

Appln. No. 10/789,596

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Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980)
(emphasis in original).

Withdrawal of the §103(a) rejection of claims 3, 4, 7 and 8 is therefore respectfully requested.

New Claims:

New claim 9 has been added to vary the scope of the claims and clarify the present invention. All limitations are supported by the original disclosure including the specification, drawings and original claims. Therefore, no new matter has been added. The new claim is believed to be allowable.

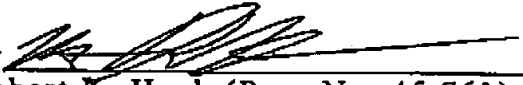
Appln. No. 10/789,596
Amendment dated November 4, 2004
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CONCLUSION

In light of the foregoing amendments and remarks, early reconsideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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